

REMARKS

Claims 1-20 are currently pending in this application, of which claims 1-20 have been rejected. Reconsideration of this application in light of the following remarks is requested.

Allowable Subject Matter

Noted with appreciation is the indication in the Office Action that claims 2, 10, and 11 are directed at allowable subject matter, and would be allowed if rewritten in independent form. However, it is respectfully submitted that claims 2, 10, and 11 depend from rejected base claims that are believed to be allowable for the reasons set forth below. Accordingly, it is believed to be unnecessary to separately place claims 2, 10, and 11 in independent form at this time.

Rejections under 35 U.S.C. §102

Claims 1, 3-9, 12-16, and 19 were rejected under 35 U.S.C. §102(e) as being anticipated by Forslow (U.S. Patent 6,608,832 hereinafter referred to as "Forslow"). This rejection is respectfully traversed, for the following reasons.

The PTO provides in MPEP § 2131 that

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).
(Emphasis added)

Therefore, to sustain the §102 rejection, Forslow must disclose each and every element in as complete detail as is contained in the pending claims.

With respect to independent claim 1, Forslow does not disclose a method that includes the features of "transferring signaling information for the multimedia service via the packet

signaling connection in alignment with the standard” and “transferring data for the multimedia service via the circuit bearer connection in alignment with the standard, wherein the multimedia service is provided to the mobile device via the network as specified by the standard even though the network does not support the required QoS functionality.”

More specifically, the Office Action indicated that Forslow discloses transferring signaling information for the multimedia service via the packet signaling connection in alignment with the standard in “column 6 lines 34-47, column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7” of Forslow. (See Office Action, pg. 3). Also, the Office Action indicated that Forslow discloses transferring data for the multimedia service via the circuit bearer connection in alignment with the standard wherein the multimedia service is provided to the mobile device via the network as specified by the standard even though the network does not support QoS functionality in “column 6, lines 34-47, column 10 lines 18-39, column 11 lines 29-42, column 11 line 56 to column 12 line 10, and Figure 7” of Forslow. (See Office Action , pg. 3).

However, Forslow further discloses that “[i]n the present invention an optimal type of mobile communication network transfer service—a circuit-switched transfer service or a packet-switched transfer—is specified on an individual application flow basis.” (Emphasis added) (Col. 5, lines 41-45). For example, each individual application flow may have a quality of service request (e.g., predictive quality of service, best effort quality of service, or low delay quality of service). Accordingly, the Forslow reference provides a mechanism that selects either a circuit-switched bearer or a packet-switched bearer that is best suited to transfer the individual application flow in accordance with its quality of service requirements. (Col. 5, line 66 to Col. 6, line 15). As clearly shown below in Figure 7 of Forslow, “the present invention provides a bearer selection and quality of service parameter mapping layer which selects for each application flow at the IP layer the best suited one of a circuit-switched bearer and a packet-switched bearer.” (Emphasis added) (Col. 12, lines 14-18).

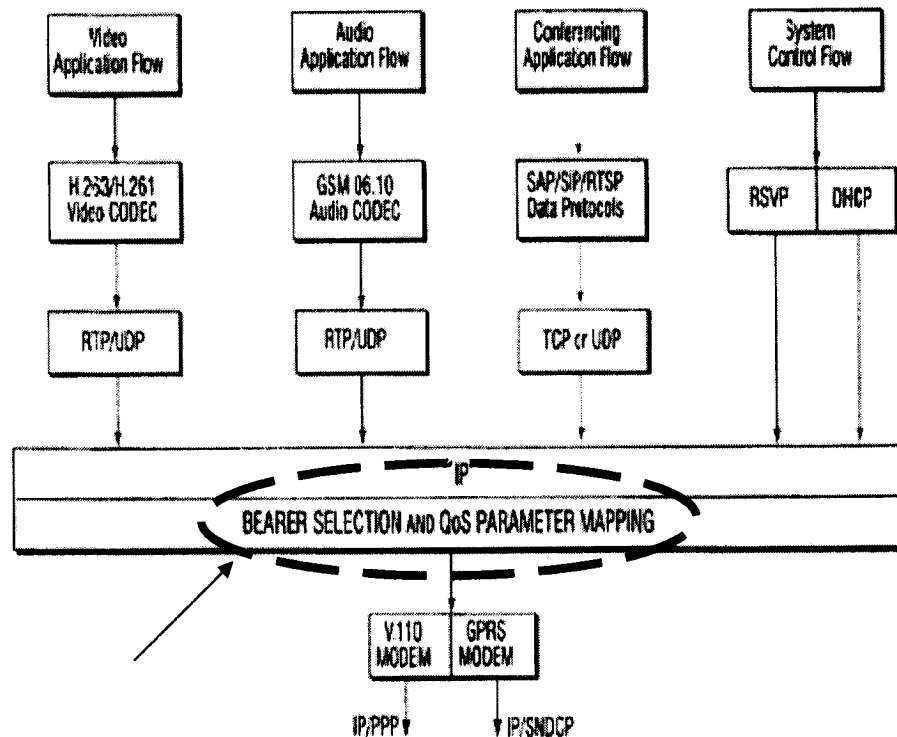


Fig. 7

Here, in contrast, the signaling information for the multimedia service is transferred via the packet signaling connection in alignment with the standard and the data for the multimedia service is transferred via the circuit bearer connection in alignment with the standard. Thus, the claimed method enables the multimedia service to be provided to a mobile device via the network as specified by the standard even though the network does not support the required quality of service (QoS) functionality. Thus, the rejection of claim 1 under 35 U.S.C. §102 is not supported by the Forslow reference and should be withdrawn.

With respect to independent claims 8 and 15, the claims were rejected under a similar rationale that was used to reject independent claim 1. Accordingly, for at least the same reasons set forth above in claim 1, the Forslow reference does not support a rejection of claims 8 and 15

under 35 U.S.C. §102. Thus, the rejection of claims 8 and 15 should be withdrawn.

With respect to dependent claims 3-7, 9, 12-14, 16, and 19, the claims depend from and further limit independent claims 1, 8, and 15, respectively, and thus are allowable for at least the same reasons set forth above. Also, claim 3 recites the feature of “controlling the transfer of data via the circuit bearer connection using the signaling information.” (Emphasis added). The Office Action indicated that Forslow discloses such a limitation in “column 6, lines 34-47, column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7.” (Office Action, pg. 4). Applicants respectfully disagree. The cited passages of Forslow disclose selecting either a circuit-switched bearer or a packet-switch bearer based on the requested quality of service (QoS) for a specific application flow. Thus, “[a] circuit-switched bearer is better suited to carrying real time services like voice and video that require low delay and/or small jitter,” the requested quality of service for voice and video application flows. (Forslow, Col. 9, lines 47-49). Accordingly, Forslow does not disclose “controlling the transfer of data via the circuit bearer connection using the signaling information,” as is recited in claim 3.

Further, claim 6 recites the feature of “maintaining the circuit bearer and packet signaling connections simultaneously.” The Office Action indicated that Forslow discloses such a limitation in “column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7.” (See Office Action, pg. 4). Applicants respectfully disagree. As discussed above, Forslow discloses selecting either a circuit-switched bearer or a packet-switch bearer based on the requested quality of service (QoS) for a specific application flow. Thus, “for each application flow, a determination is made whether a circuit-switched or a packet-switched bearer should be established.” (Emphasis added) (Forslow, Col. 5, lines 58-60). Accordingly, Forslow does not disclose “maintaining the circuit bearer and packet signaling connections simultaneously,” as is recited in claim 6.

Rejections under 35 U.S.C. §103

Claims 17, 18, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Forslow in view of Surdilla et al. (U.S. Publication US 2002/0110104 hereinafter referred to as "Surdilla"). Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 15, from which claims 17, 18, and 20 depend from.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, a *prima facie* case of obviousness cannot be maintained for the following reasons. Forslow cannot be applied to reject claim 15 under 35 U.S.C. § 103(a) which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be considered. However, the Forslow reference does not disclose nor suggest, all the claim limitations of claim 15 as was discussed above. It is respectfully submitted that the Surdilla reference does not cure the deficiencies of Forslow.

Accordingly, even when combined the Forslow and Surdilla references do not disclose all of the recited limitations of claims 17, 18, and 20. For at least this reason a *prima facie* case of obviousness cannot be supported with respect to claims 17, 18, and 20. Thus, Applicants request that the 35 U.S.C. §103 rejection of claims 17, 18, and 20 over the Forslow and Surdilla references be withdrawn.

Conclusion

It is clear from all of the foregoing that independent claims 1, 8, and 15 are in condition for allowance. Dependent claims 2-7, 9-14, and 16-20 depend from and further limit independent claims 1, 8, and 15 and therefore are allowable as well.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



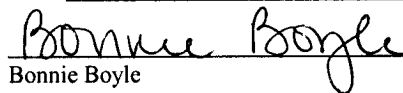
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Date: October 29, 2008



Bonnie Boyle